



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/216,440	03/23/94	ZHOU Y	418634ALLNCO

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12M2/0424

JORDAN, K

EXAMINER

ART UNIT

1205

PAPER NUMBER

29

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED: 04/24/95

☐ This application has been examined ☒ Responsive to communication filed on January 17, 1995. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 months from the date of this letter.
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 27-29 and 31-32 are pending in the application.
Of the above claims, are withdrawn from consideration.
2. ☒ Claims 1-26 and 30 have been cancelled.
3. ☐ Claims are allowed.
4. ☒ Claims 27-29 and 31-32 are rejected.
5. ☐ Claims are objected to.
6. ☐ Claims are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on . Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. ; filed on .
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 1205

Claims 27-29 and 31-32 are pending in this application.

The amendment received on January 17, 1995 has been entered.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

The specification is enabling only for those ratios demonstrated to be synergistic of the combination of artemether and benflumetol. The specification is not enabling for all ratios or all synergistic ratios, only the ratios demonstrated to have synergistic effectiveness.

Claims 27-29 and 31-32 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit 1205

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

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Claims 27-~~28~~ and 31-32 are rejected under 35 U.S.C. § 103 as being unpatentable over Deng (AQ) in view of Wang et al. (R), and Lin et al. (S).

The claims appear to be drawn to compositions and methods for treating malaria by orally administering synergistically effective amounts of benflumetol and artemether. Deng discloses that the combination of benflumetol and artemether has synergistic activity in the treatment of malaria (see page 375, left column, lines 3-13). The claims differ from the primary reference in claiming oral administration of the compounds and specific synergistic ratios. To administer benflumetol orally would have been obvious in view of Wang et al. which discloses the formulation of benflumetol in gelatin capsules which are known to be used as an oral dosage form. To administer artemether orally would have been obvious in view of Lin et al. which teaches artemether as an antimalarial and administered orally. The choice of specific synergistic ratios also would have been obvious given that Deng had already disclosed the synergistic phenoma that exists between benflumetol and artemether. Such ratios are only the optimization of Deng's teaching. The claims fail to patentably distinguish over the state of the art as represented by the cited references.

Art Unit 1205

The applicants' ^{remarks} have been considered but are not persuasive and are now moot in light of the newly cited prior art and the newly made obviousness rejection.

No claims are allowed.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Jordan whose telephone number is (703) 308-4611.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in cursive script, appearing to read "Kimberly Jordan", with a long horizontal flourish extending to the right.

JORDAN:jd
April 18, 1995